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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,591	10/24/2001	Pablo Munoz JR.	B-0103.29	2215

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EXAMINER	
MRUK, BRIAN P	
ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/039,591

**Applicant(s)**

MUNOZ ET AL.

**Examiner**

Brian P Mruk

**Art Unit**

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office action is in response to Applicant's amendment filed November 2, 2004. Applicant has amended claims 59, 61, 62, and 64--71. New claims 72-76 have been added. Currently, claims 59-76 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 20040429.
3. The objection of claims 67-68 and 70-71 is withdrawn in view of applicant's amendments and remarks.
4. The rejection of claims 61 and 62-71 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks.
5. The rejection of claims 59-71 under 35 U.S.C. 102(b) as being anticipated by Onan et al, U.S. Patent No. 5,968,879, is maintained for the reasons of record.

### **NEW GROUNDS OF REJECTION**

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1751

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 72-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Onan et al, U.S. Patent No. 5,968,879.

Onan et al, U.S. Patent No. 5,968,879, discloses a polymeric composition comprising water, a water-soluble monomer, an initiator, and an oxygen scavenger (see col. 2, lines 25-42). It is further taught by Onan et al that the water includes fresh water, seawater, brine, or water containing various salts (see col. 3, lines 25-30), and that the composition may also contain i) an oxygen scavenger, such as hydrochloric acid (see col. 4, lines 40-49), ii) a gelling agent, such as cellulose derivatives and guar gum (see col. 4, lines 50-65), iii) a foaming agent, such as an ammonium alcohol ether sulfate (see col. 5, lines 25-50), iv) a foam stabilizing agent, such as methoxypolyethylene glycol (see col. 6, lines 29-67), and a gas, such as nitrogen (see col. 5, lines 15-24 and col. 9, lines 19-20). Specifically, note Example Nos. 8-10 in Table II, which were made by adding hydroxyethylcellulose, a sulfated linear alcohol ethoxylate, methoxypolyethylene glycol, silica, hydrochloric acid, and hydroxyethylacrylate to a solution of synthetic seawater, per the requirements of instant claims 72-76. Therefore, instant claims 72-76 are anticipated by Onan et al, U.S. Patent No. 5,968,879.

***Response to Arguments***

Art Unit: 1751

8. Applicant's arguments filed November 2, 2004 have been fully considered but they are not persuasive.

Applicant argues that Onan et al, U.S. Patent No. 5,968,879, does not teach or suggest in general a composition that contains a water miscible solvent. However, the examiner asserts that Onan et al does indeed teach this limitation. Specifically, Examples 8-10 in Table II of Onan et al contain methoxypolyethylene glycol (i.e. as the foam stabilizer), which is a well known hygroscopic liquid that is miscible with water.

It is further argued by applicant that Onan et al does not teach that the composition is used to contact contaminants, such as brine. However, the examiner respectfully disagrees. Specifically, Onan et al clearly teach that the composition is used in contact with brine (see col. 3, lines 25-30 of Onan et al), which clearly meets applicant's requirements of "contacting brine". Furthermore, the examiner asserts that the brine does not have to be present as a contaminant, since the process step only requires the contacting of brine with the composition. Also, it is noted by the examiner that applicant's claims 60 and 63 recite that the composition "may be contacted with brine", which is an optional step that is not required.

Applicant further argues that Onan et al do not teach or suggest in general the limitations found in dependent claims 61 and 64-76. However, the examiner asserts that dependent claims 61 and 64-76 are clearly met by Onan et al, since applicant's claims, as presently written, indicate that the contaminants may comprise up to 50% by weight of the composition, which include compositions that include 0% by weight of the

Art Unit: 1751

contaminants. Thus, since these contaminants are optional, the examiner asserts that the instant claims are still anticipated by Onan et al.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1751

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

BPM

Brian Mruk  
March 14, 2005



Brian P. Mruk  
Primary Examiner  
Tech Center 1700